

A3  
Contd

9. (Amended) A flexible packaging film laminate as in claim 8 including a first tie layer disposed between said first polyolefin layer and said flexible, polyamide containing, coextruded film.

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A4

11. (Amended) A flexible packaging film laminate as in claim 10 in which said flexible, polyamide containing, coextruded film includes an oxygen barrier layer adhered to said first polyamide layer.

12. (Amended) A flexible packaging film laminate as in claim 11 in which said flexible, polyamide containing, coextruded film includes a second polyamide layer adhered to said oxygen barrier layer on the side opposite said first polyamide layer.

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A5

14. (Amended) A flexible packaging film laminate as in claim 13 including a second outer layer of polyolefin adhered to said second tie layer.

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Please add new claims 15-20 as follows:

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A6

15. A flexible packaging film laminate having at least three layers comprising:  
an outer layer comprising a biaxially oriented polyester film having an outer surface and an inner surface;  
an image positioned on a surface of said biaxially oriented polyester film; and,  
a flexible, polyamide containing, coextruded film adhered to said biaxially oriented polyester film.

16. A flexible packaging film laminate according to claim 15, wherein said image is positioned on said inner surface of said biaxially oriented polyester film, and said flexible, polyamide containing, coextruded film is adhered to said inner surface so as to cover and protect said image.

17. A flexible packaging film laminate according to claim 15, wherein said flexible, polyamide containing, coextruded film comprises a semi crystalline polyamide layer.

18. A flexible packaging film laminate according to claim 15, wherein said flexible, polyamide containing, coextruded film includes at least one layer comprising a blend of a semi-crystalline polyamide and an amorphous polyamide.

19. A flexible packaging film laminate according to claim 15, wherein said flexible, polyamide containing, coextruded film comprises a three-layer film including a first polyamide layer, a second polyamide layer and an oxygen barrier layer disposed between said first and second polyamide layers.

20. A flexible packaging film laminate comprising:

an outer layer of biaxially oriented polyester film having an outer surface and an inner surface;

an image disposed on said inner surface;

an adhesive layer positioned to overlie said image;

a first polyolefin layer adhered to said adhesive layer;

a first tie layer adjacent said first polyolefin layer;

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a first polyamide layer adjacent said first tie layer;  
an oxygen barrier layer adjacent said first polyamide layer;  
a second polyamide layer adjacent said oxygen barrier layer;  
a second tie layer adjacent said second polyamide layer; and,  
a second polyolefin layer adjacent said second tie layer.

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### REMARKS

Reconsideration and withdrawal of the outstanding rejections is requested. Upon entry of the amendment, claims 1 - 20 will be pending in the application, claims 1, 3-5, 7-9, 11-12 and 14 will be amended, claims 15-20 are new. Claim 2 has been cancelled. The claims have been amended to more clearly recite Applicants' invention and not to overcome the cited prior art. No new matter has been added.

### **Section 112 Rejections**

The Examiner has rejected claims 1, 5, and 7-14 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

w/d

The Examiner, in rejecting claim 1, states that the term "including" is an improper transition term which does not define the scope of the claims. Applicants direct the Examiner's attention to the Manual of Patent Examining Procedure, Section 2111.03 which states: the transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. (Citing Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261, 229

USPQ 805 (Fed.Cir. 1986). The term "including" is synonymous with the clearly acceptable term "comprising" and the rejection is requested to be withdrawn.

WD The Examiner has also rejected claim 1 under §112 because the Examiner is not clear what the term "formable" means. The Examiner states that if Applicants intend it to mean "capable of forming", that such a meaning is indefinite as it adds no positive limitation to the claim. Claim 1, as amended, is believed to obviate the Examiner's rejection. The term "formable" has been deleted. The rejection as to amended claim 1 is requested to be withdrawn.

WD The Examiner rejects claim 5 due to the inclusion of the numerals "10a" and "10b" and for lack of antecedent basis for the elements "first 10a and second 10b polyamide layers". Claim 5, as amended, is believed to obviate the Examiner's rejection. The reference numerals "10a" and "10b" have been deleted and proper antecedent basis has been included for "a first polyamide layer and a second polyamide layer". The rejection is requested to be withdrawn.

WD The Examiner further indicated in the Office Action that claims 7-14 are rejected under 35 U.S.C. §112; however, the Examiner has not explained any basis for the indefiniteness. It is submitted that these claims are definite and precisely claim the invention and that the rejection of these claims on the basis of indefiniteness should be withdrawn.

### **Section 102 Rejections**

The Examiner has rejected claims 1-14 under 35 U.S.C. §102(e) as being anticipated by Ramesh, U.S. Patent No. 6,346,285. Claims 1-14 all claim a flexible packaging film laminate including an outer layer of biaxially oriented polyester having an image positioned on a surface thereof; and the outer layer adhered to a flexible, polyamide containing, coextruded film. Applicants respectfully traverse these rejections for the following reasons.

The Examiner states, in pertinent part:

Ramesh shows a film comprising a biaxially oriented polyester layer 24 which can comprise an image and dye (column 17, lines 59-65) which is adhered to a coextruded polyamide layer or semicrystalline and amorphous polyamide nylon layer (column 24, lines 35-43) or EVOH layer 28 (flexible polyamide containing coextruded film)(Figure 2, column 2, lines 64-65, and column 6, lines 24-32). Ramesh shows a polyolefin layer 26 (first polyolefin layer) which is adhered to the dyed polyester layer 24 (Figure 2) Ramesh further shows a tie layer 32 adhered to the polyolefin layer 26 and that the polyamide core 28 (first polyamide layer) is adhered to the tie layer 32 (Figure 2). (Paper No. 5, page 2, paragraph 2.)

Applicants respectfully submit that such an interpretation is an inaccurate reading of U.S.

Patent No. 6,346,285. First, at column 17, lines 59-65, the Ramesh reference discloses that the polymer layers of the disclosed film:

... may also contain appropriate amounts of additives typically included in such compositions. These additives include slip agents such as talc, antioxidants, fillers, dyes, pigments, radiation stabilizers, antistatic agents, elastomers, and like additives known to those of skill in the art of packaging films. [Emphasis added]

Clearly, additives added to the polymer compositions which make up individual layers of the coextruded film disclosed by Ramesh are not an image positioned on a surface of the outer biaxially oriented polyester layer, as required by the claims of the present invention. Additives are introduced to the resin mixture prior to extrusion through a die and are dispersed throughout the entire layer. Ramesh suggests that a film layer may be colored, but does not teach or suggest an image on a surface of a biaxially oriented polyester film. Applicants' claims require an image, which is positioned on a surface of a biaxially oriented polyester layer. Thus, Ramesh does not anticipate Applicants' claims and the rejection should be withdrawn.

ADD REVD

Second, outer layer 24 of multilayer film 22 depicted in Figure 2 of the Ramesh reference is described as a seal layer and is "the first film layer" of the Ramesh patent. (See column 16, lines 25-27). The "first layer" of the Ramesh invention is described at column 13, lines 44-52 as being "a polyamide having a melting point of from about 260° F to 400° F." There is no disclosure or suggestion within Ramesh that outer layer 24, a "first layer" of the Ramesh

col 3

reference, should be or is a biaxially oriented polyester film. Ramesh teaches that it is a polyamide layer.

Lastly, the Examiner contends that "the polyamide core 28 comprises at least one member selected from the group consisting of a polyamide and EVOH (column 15, lines 16-35) and that the core layer can comprise multiple core layers (column 12, lines 6-14)." (Paper No. 5, page 3, 3rd paragraph.) This is a misreading of the '285 patent. Ramesh discloses at column 15, lines 16-35, that the "third layer" of the '285 patent comprises at least one member selected from the group consisting of EVOH and polyamide, among other possibilities. Thus, Ramesh suggests the "third layer" may be a blend of EVOH and a polyamide, but the Ramesh reference does not disclose or suggest a flexible, polyamide containing, coextruded film comprising a first polyamide layer, a second polyamide layer and an oxygen barrier layer disposed between the first and second polyamide layers as required by Applicants' claims .

col 2  
Ramesh

From the above, it is readily apparent that Ramesh '285 does not teach each and every feature recited in Applicants' claims whereby an anticipation rejection is inappropriate. Accordingly, this ground of rejection should be withdrawn.

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### **Product-by-process Rejections**

The Examiner further rejects claim 2 "because it is a product-by-process claim." (Paper 5, page 3, last paragraph). The Examiner suggests that the terms "said image is printed", said printed outer layer is adhered" and "so as to cover and protect" are process limitations that render claim 2 unpatentable. Likewise, the Examiner rejects claims 1 and 8-14 "because the phrases 'adhered to' introduces [sic] a process limitation to the product claim." (Paper 5, page 4, first full paragraph). Claim 2 has been cancelled, therefore the rejection of claims 1 and 8-14 will be addressed below.

Applicants respectfully submit that the foregoing terms are not process limitations when read in context, but merely structural limitations used in the flexible film art. The Federal Circuit, in *Hazani v. United States Int'l Trade Comm'n.*, 126 F.3d 1473, 44 USPQ.2d 1358, 1363 (Fed. Cir. 1997), found the term “chemically engraved,” when read in context, described the product more by its structure than the process used to obtain it. Applicants submit that use of the phrases “said image is printed” and “adhered to”, when read in context of a flexible packaging film, describe the product by its structure and not the process used to obtain it. The term “a printed image” is a structural limitation not a process limitation. Furthermore, claim 1, as amended, no longer refers to an image “printed” on a surface, but has been changed to an image “positioned” on a surface of the outer layer. Clearly this overcomes any possible objection based on process terms. b7c  
-T256

Without conceding that claims 1 and 8-14 are product-by-process claims, Applicants note that product-by-process claims are not prohibited. The Examiner cites to MPEP § 2113 for this proposition; however, that section of the manual merely states that established law requires the Examiner to compare the product of a product-by-process claim against the prior art product for purposes of patentability. There is no suggestion within § 2113 that product-by-process claims are impermissible per se. Applicants direct the Examiner's attention to MPEP § 2173.05(p), which states:

There are many situations where claims are permissively drafted to include a reference to more than one statutory class of invention. A product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made, **is proper**. [Emphasis added] *In re Luck*, 476 F.2d 650, 177 USPQ 523 (CCPA 1973); *In re Pilkington*, 411 F.2d 1345, 162 USPQ 145 (CCPA 1969); *In re Steppan*, 394 F.2d 1013, 156 USPQ 143 (CCPA 1967). A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable under 35 U.S.C. 112, second paragraph, so long as it is clear that the claim is directed to the product and not the process.

An applicant may present claims of varying scope even if it is necessary to describe the claimed product in product-by-process terms. *Ex parte Pantzer*, 176 USPQ 141 (Bd. App. 1972).

From the foregoing discussion with respect to the §102 rejections, it is readily apparent that when the subject matter of Applicants' claims 1 and 8-14, as amended, is compared to the teaching of the Ramesh '285, the cited reference neither anticipates these claims nor renders them obvious. Ramesh '285 does not disclose an image disposed on a biaxially oriented polyester. Thus, claims 1 and 8-14, as amended, are not anticipated by the Ramesh '285 reference. Since there is no hint or suggestion of positioning an image on the Ramesh film, there is no basis for converting a §102 rejection to a §103 rejection. Therefore, Applicants respectfully request that the rejection of these claims be withdrawn.

### **Conclusion**

In view of the above arguments and amendments, withdrawal of the rejections are requested, and early allowance of all claims is solicited. If the Examiner has any questions regarding this response, the Examiner is invited to contact the undersigned.

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Respectfully submitted,



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**Version with markings to show the changes made.**

1. (Amended) A flexible packaging film laminate including:  
an outer layer of [formable] biaxially oriented polyester; <sup>1212</sup>  
an image [printed] <sup>imp lack of emb flow</sup> positioned on a surface of said outer layer; and  
[said printed outer layer adhered to] a flexible, polyamide containing, coextruded film  
adhered to said polyester layer [so as to cover and protect said image.]
3. (Amended) A flexible packaging film laminate as in claim 1 in which said flexible,  
polyamide containing, coextruded film includes a [semi crystalline] semi-crystalline  
polyamide layer.
4. (Amended) A flexible packaging film laminate as in claim 1 in which said flexible,  
polyamide containing, coextruded film includes a layer comprising [consisting of] a blend of  
a semi-crystalline polyamide and an amorphous polyamide.
5. (Amended) A flexible packaging film laminate as in claim 1 in which said flexible,  
polyamide containing, coextruded film comprises an oxygen barrier layer sandwiched  
between a first polyamide layer [10a] and a second [10b] polyamide layer[s].
7. (Amended) A flexible packaging film laminate as in claim [2] 1 including a layer of  
adhesive disposed between said image and said flexible, polyamide containing, coextruded  
film, said layer of adhesive covering and protecting said [printed] image.

8. (Amended) A flexible packaging film laminate as in claim 7 including a first polyolefin layer adhered to said layer of adhesive and said flexible, polyamide containing, coextruded film disposed adjacent said first polyolefin layer.

9. (Amended) A flexible packaging film laminate as in claim 8 including a first tie layer [adhered to] disposed between said first polyolefin layer and said flexible, polyamide containing, coextruded film.

11. (Amended) A flexible packaging film laminate as in claim 10 [including] in which said flexible, polyamide containing, coextruded film includes an oxygen barrier layer adhered to said first polyamide layer.

12. (Amended) A flexible packaging film laminate as in claim 11 [including] in which said flexible, polyamide containing, coextruded film includes a second polyamide layer adhered to said oxygen barrier layer on the side opposite said first polyamide layer.

14. (Amended) A flexible packaging film laminate as in claim 13 including [an] a second outer layer of polyolefin adhered to said second tie layer.

15. A flexible packaging film laminate having at least three layers comprising:  
an outer layer comprising a biaxially oriented polyester film having an outer surface and an inner surface;  
an image positioned on a surface of said biaxially oriented polyester film; and,

a flexible, polyamide containing, coextruded film adhered to said biaxially oriented polyester film.

16. A flexible packaging film laminate according to claim 15, wherein said image is positioned on said inner surface of said biaxially oriented polyester film, and said flexible, polyamide containing, coextruded film is adhered to said inner surface so as to cover and protect said image.

17. A flexible packaging film laminate according to claim 15, wherein said flexible, polyamide containing, coextruded film comprises a semi crystalline polyamide layer.

18. A flexible packaging film laminate according to claim 15, wherein said flexible, polyamide containing, coextruded film includes at least one layer comprising a blend of a semi-crystalline polyamide and an amorphous polyamide.

19. A flexible packaging film laminate according to claim 15, wherein said flexible, polyamide containing, coextruded film comprises a three-layer film including a first polyamide layer, a second polyamide layer and an oxygen barrier layer disposed between said first and second polyamide layers.

20. A flexible packaging film laminate comprising:  
an outer layer of biaxially oriented polyester film having an outer surface and an inner surface;  
an image disposed on said inner surface;

an adhesive layer positioned to overlie said image;  
a first polyolefin layer adhered to said adhesive layer;  
a first tie layer adjacent said first polyolefin layer;  
a first polyamide layer adjacent said first tie layer;  
an oxygen barrier layer adjacent said first polyamide layer;  
a second polyamide layer adjacent said oxygen barrier layer;  
a second tie layer adjacent said second polyamide layer; and,  
a second polyolefin layer adjacent said second tie layer.